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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/723,013

11/27/2000

Michael H. Coden

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FOGG AND ASSOCIATES, LLC
P.O. BOX 581339
MINNEAPOLIS, MN 55458-1339

EXAMINER

NGUYEN, STEVEN H D

ART UNIT

PAPER NUMBER

2665

7

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/723,013

Applicant(s)

CODEN, MICHAEL H.

Examiner

Steven HD Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 52-116 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 52-116 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3 and 5</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION***Claim Objections***

1. Claim 59 is objected to because of the following informalities:

As claim 59, "PLI" should be changed to - PCI --. Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 52-90, 93-99, 102-106, 109-113 and 116 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12, 16, 18-48 of U.S. Patent No. 6154462. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent encompass a ring switch comprising a table for tracking the addresses of the devices on the local network and using the table for determining if the packet should route to a local port or onto the ring port. The application's claims are nearly identical in every other respect to the patent claims. Therefore, the applicant simply broader versions of the

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patent claims. It is the examiner's position that broadening the patented claims by not claiming some of claim elements (i.e not includes in the ring switches etc..) of the patented claims would have been obvious to one of ordinary skill in the art in view of the patented claims. It is important to note that the instant application is a continuation of the application that yielded the patent (USP 6154462) used herein as the basis for the obviousness type of double patenting rejection. The applicant is attempting to broaden the parent application's claims by eliminating some of the claim elements in the continuation at issue here. If allowed, the application at bar would unjustly extend applicant patent protection beyond the statutory period of twenty years while, at the same time, granting broader protection to the application.

3. Regarding claims 91-92, 100-101, 107-108 and 114-115, the claims of the patent do not encompass these claims of the present application. However, switch ID and counter for using to discard the packet around the ring are well known and expected in the art at the time of invention was made to implement these methods in order to improve throughput of the ring.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 109-110, 113 and 116 are rejected under 35 U.S.C. 102(b) as being anticipated by McCreary (USP 5384566).

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McCreary discloses (Figs 1-4 and col. 1, lines 5 to col. 9, lines 50) a ring network comprising a plurality of ring switches (Fig 1, Ref 20) wherein each of ring switch comprising ring in port and ring out port and a local port (Fig 2), receiving a packet from a ring in port, routing the packet that destined for a network device of local port and routing the packet is not destined to a local device to ring out port for transmitting the packet back onto the ring without using token or encapsulating, discarding the packet if source address of the packet is associated with a local device, (col. 6, lines 11 to col. 7, lines 13).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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8. Claims 52-53, 56, 58, 60-62, 66-67, 70, 73-76, 78-80, 82-84, 86-90, 93-99, 102-103, 105-106, 109-110, 112-113 and 116 are rejected under 35 U.S.C. 103(a) as being unpatentable over Konishi (USP 4933937) in view of McCreary (USP 5384566).

Regarding claims 52-53, 56, 58, 60-62, 66-67, 70, 73-76, 80, 82-84, 86-90, 93-99, 102-103, 105-106, 109-110, 112-113 and 116, Konishi discloses (Figs 1-6 and col. 1, lines 5 to col. 6, lines 52) a ring switch (Fig 2) comprising at least one port for coupling to the ring (11) and a local port for coupling to LAN (13-1); at least one table for learning the source and destination address of the packet which is received into the ring switch (Figs 5-6). However, Konishi does not disclose a method and system for determining if the received packet from the ring should be forwarded to the local port or ring port based on the table by comparing destination address with a table and removed from the ring by comparing the source address or destination address of the received packet. In the same field of endeavor, McCreary discloses (Figs 1-4 and col. 1, lines 5 to col. 9, lines 50) a ring switch for receiving a packet from a ring and routing the packet to a local port or back onto the ring by comparing the destination address of the data packet with the address of the device in the local network, if the destination address is match with a local address, the packet is removed from the ring and forwarding at least one device on the local network based on destination address or group address via a local port, otherwise the packet is rerouted back onto the ring and the ring switch removes the packet from the ring based on the source or destination address of the packet without using token or encapsulating (See Figs 1-2 and col. 6, lines 11 to col. 7, lines 13).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method and system for removing the packet on

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the ring based on source or destination address of a packet and placing the packet back onto the ring based on the destination address of the packet as disclosed by McCreary into the method and system of Konishi. The motivation would have been to improve the throughput of the ring.

9. Claims 54, 55, 57, 59, 63-65, 68-69, 71-72, 77-79, 81, 85, 91-92, 100-101, 104, 107-108, 111 and 114-115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Konishi and McCreary as applied to claims 52, 61, 67, 80, 83, 86, 93, 102 and 109 above, and further in view of Chin (USP 5617421).

Regarding claims 54, 63, 68, 81, 85, Konishi and McCreary fail to disclose a table with an indication that the data packets that destination for source address should be transmitted back on the ring. In the same field of endeavor, Chin discloses a table with an indication that the data packets that destination for source address is local at a remote switch (Col. 13-14, table 1-3, local or remote bit).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method and system for storing an indication in the table for indicating if the source address is local address or remote address as disclosed by Chin into the method and system Konishi and McCreary. The motivation would have been to provide a path between the source and destination.

Regarding claims 55, 64, 69, 71-72, 77-79, 104, 111, Konishi and McCreary fail to disclose a bi-direction ring port. However, in the same field of endeavor, Chin discloses a ring switch comprising a bi-direction port (Fig 4, Link AB).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a bi-direction port into a ring switch as disclosed

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by Chin into the method and system of Konishi and McCreary. The motivation would have been to provide a redundant path between the ring switch.

Regarding claims 57, 59 and 65, Konishi and McCreary fail to disclose PCB, PCI. However, the examiner takes an official notice that a method and system for implementing a circuit on a PCB and having PCI are well known and expected in the art at the time invention was made to increase speed and cost to build the ring switch.

Regarding claims 91-92, 100-101, 107-108 and 114-115, Konishi and McCreary fail to disclose a step of discarding the packet based on ring switch ID or hop count. However, the examiner takes an official notice that a method and system for discarding the packet based on a switch ID and hop count are well known and expected in the art at the time of invention was made in order to improve the through put of the network.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bederman (USP 4567590) discloses a method and system for routing and discarding the packet around a ring network.

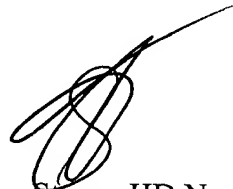
Tojima (USP 4996524) discloses a method and system for learning the addresses of the packet

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on 8-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D Vu can be reached on (703) 308-6602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven HD Nguyen
Primary Examiner
Art Unit 2665
7/9/04